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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,009	07/24/2003	Ashoke K. SenGupta	28216/38681B	9906
4743	7590	10/04/2007	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP			CHEUNG, WILLIAM K	
233 S. WACKER DRIVE, SUITE 6300			ART UNIT	PAPER NUMBER
SEARS TOWER			1796	
CHICAGO, IL 60606				
MAIL DATE		DELIVERY MODE		
10/04/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/626,009	SENGUPTA ET AL.	
	<b>Examiner</b> William K. Cheung	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 8/1/07.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,14-18 and 34-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,14-18 and 34-53 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Request for Continued Examination***

1. The request filed on August 1, 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/626,009 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of the amendment filed August 1, 2007, claims 6-13 have been cancelled. Claims 1-5, 14-18, 34-53 are pending.
3. In view of the amendment filed August 1, 2007, the rejection of Claims 38-53 under 35 U.S.C. 112, first paragraph, is withdrawn.

***Claim Objections***

4. Claims 1-5, 14-18, 34-37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 (line 5), the recitation "PEG 30 dipolyhydroxystearate" should be recited as "PEG-30 dipolyhydroxystearate" ..

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-5, 14-18, 34-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lukenbach et al. (WO 01/01949) for the reasons adequately set forth from paragraph 7 of the office action of February 1, 2007.

*The invention of claims 1-5, 14-18, 34-37 relates to a composition for thickening hydrophobic liquids comprising a smectic clay selected from the group consisting of bentonite, montmorillonite, saponite, hectorite, beidellite, stevensite, and mixture thereof, surfaces of said smectic clay modified by an amphipathic copolymer comprising PEG-30 dipolyhydroxystearate.*

Lukenbach et al. (page 51, claim 28) disclose a silicate material comprising a PEG-30 dipolyhydroxylstearate. Lukenbach et al. (page 13, line 18-20) disclose the composition comprises mica, alumina, silica, calcium silicate (a wollastonite clay), sodium magnesium fluorosilicate (a modified version of talc or bentonite clay), and mixture thereof. Lukenback et al. (page 14, line 1-2) also disclose the incorporation of propylene glycol, hexylene glycol, butylenes glycol which can function as thickening aid. Lukenbach et al. (page 15, line 10-11) disclose the incorporation of lipophilic (hydrophobic) compounds which include liquid hydrocarbon such as hydrogenated polydecene/ cetyl alcohol, stearyl alcohol mixture. In view of the substantially identical composition and the incorporation of similar components such as calcium silicate (a wollastonite clay) and sodium magnesium fluorosilicate (a modified version of talc or

bentonite clay) between the composition of Lukenbach et al. and the composition of claims 1-7, 14-18, 34-37, the examiner has a reasonable basis that the claimed "layered" feature and the "amphiphathic" feature of claim 1, the "smectic" feature of claim 7, and the viscosity features of claims 35-36 are inherently possessed in Lukenbach et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

Applicant's arguments filed August 1, 2007 have been fully considered but they are not persuasive. Applicants argue that the Declaration filed August 1, 2007 (Table 1) contain "unexpected results" in the increase in Brookfield viscosity. However, applicants fail to recognize that the results as recited in Table 1 is not effective for overcoming the 102 portion of the 102-3 rejection set forth. Further, applicants fail to recognize that there is no viscosity reading for sample No. 2. What is the maximum of the Brookfield Viscometer employed? Furthermore, applicants fail to submit an example with no clay but with PEG-30 dipolyhydroxystearate to show that the PEG-30 dipolyhydroxystearate by itself would not have caused the viscosity increase.

8. Claims 38-53 are rejected under 35 U.S.C. 103(a) as obvious over Lukenbach et al. (WO 01/01949).

Lukenbach et al. (page 51, claim 28) disclose a silicate material comprising dimethicone copolymer, which generically include the BIS-PEG-15 Dimethicone/IPDI Copolymer as claimed. Lukenbach et al. (page 13, line 18-20) disclose the composition comprises mica, alumina, silica, calcium silicate (a wollastonite clay), sodium magnesium fluorosilicate (a modified version of talc or bentonite clay), and mixture thereof. Lukenback et al. (page 14, line 1-2) also disclose the incorporation of propylene glycol, hexylene glycol, butylenes glycol which can function as thickening aid. Lukenbach et al. (page 15, line 10-11) disclose the incorporation of lipophilic (hydrophobic) compounds which include liquid hydrocarbon such as hydrogenated polydecene/ cetyl alcohol, stearyl alcohol mixture. In view of the substantially identical composition and the incorporation of similar components such as calcium silicate (a wollastonite clay) and sodium magnesium fluorosilicate (a modified version of talc or bentonite clay) between the composition of Lukenbach et al. and the composition of claims 1-7, 14-18, 34-37, the examiner has a reasonable basis that the claimed "layered" feature and the "amphiphathic" feature of claim 1, the "smectic" feature of claim 7, and the viscosity features of claims 35-36 are inherently possessed in Lukenbach et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

The difference between the invention of claims 38-53 and Lukenback et al. is that Lukenback et al. do not disclose the specific dimethicone copolymer as claimed.

However, Lukenbach et al. (page 51, claim 28) disclose a silicate material comprising dimethicone copolymer, which generically include the BIS-PEG-15 Dimethicone/IPDI Copolymer as claimed. Since Lukenback et al. disclose the dimethicone copolymer within a claim, Lukenback et al. clearly indicate the inclusion of the claimed copolymer as part of the scope of claim 28 of Lukenbach et al. Motivated by the expectation of success of developing the cleansing composition of Lukenback et al. (page 1, line 6-12), it would have been obvious to one of ordinary skill in art to recognize and appreciate any dimethicone copolymer would be suitable for the preparation of the cleansing composition of Lukenbach et al. to obtain the invention of claims 38-53.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

WILLIAM K. CHEUNG  
PRIMARY EXAMINER

September 29, 2007